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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/614,114	07/07/2003	Richard Levy	01064.0011-08-000	7674

7590 04/19/2006

THE LAW OFFICES OF ROBERT J. EICHELBURG
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EXAMINER	
GRAY, JILL M	

ART UNIT	PAPER NUMBER
1774	

DATE MAILED: 04/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/614,114	LEVY, RICHARD	
	Examiner	Art Unit	
	Jill M. Gray	1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 September 2005 and 02 February 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *57-63,65-71,73,76 and 87-91* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *57-63,65-71,73,76 and 87-91* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *9/2/05;11/2/05*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. In view of the Appeal Brief filed on February 2, 2006, PROSECUTION IS HEREBY REOPENED. An Office Action is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

Response to Amendment

The rejection of claims 57-63, 65-71, 73, 76, and 87-90 under 35 U.S.C. 103(a) as being unpatentable over Freeman 5,218,011 in view of Marciano-Agostinelli et al, 5,049,593 is withdrawn in view of applicants' amendment of September 16, 2005.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any

> person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 62 and 70 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the substrate comprising a cable when polyisobutylene is the lubricant, does not reasonably provide enablement for the substrate being a cable and having any lubricating metal and alloy thereof, lubricating metal chalcogenide, halide, carbonate, silicate or phosphate or particulate lubricating metal nitride or carbon lubricant or silicate ester, polyphenyl ether, organic phosphate, biphenyl, phenanthrene or phthalocyanine compound or any organic lubricant, inorganic lubricant or lubricant additive. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. In particular, the specification as originally filed only teaches polyisobutylene as a lubricant for cable applications. Accordingly, the claims are not commensurate in scope with the specification.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 91 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

More specifically, this claim uses improper Markush language. The suggested language is "selected from the group consisting of".

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 57-63, 65-71, 73, 76, and 87-91 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pertinelli et al, 4,621,169 (Pertinelli) in view of Freeman 5,218,011.

Pertinelli teaches a cable and wire substrate coated with an essentially water-free composition, wherein said composition comprises a metal or metal oxide of metal such as zinc, copper or aluminum, or carbon or graphite, as required by claims 57, 62-63, 65, 70-71, and 91. See column 3, lines 61-65. Pertinelli also teaches that his composition has an organic lubricant of the type contemplated by applicant in claims 58, 61, 66, and 69. See column 3, lines 40-51. Also, Pertinelli teaches that his composition protects from the affects of water or water migration, per claims 89-90. See abstract. Pertinelli does not teach the inclusion of a superabsorbent polymer.

Freeman teaches an essentially water-free gel composition and method for protecting a substrate such as wires and able from damage by water, said gel composition comprising a gel matrix, thickener and water absorbent polymer dispersed therein, wherein the gel matrix can be silicones, petroleum gels, high viscosity esters (fatty oils), glycols, olefins, mineral oil and fluorocarbons, as

required by claims 57-58, 61-63, 65-66, 69-71, and 89-90. See abstract and column 7, lines 19-39 and line 58 through column 8 and line 9. In addition, Freeman teaches that the superabsorbent polymer can be based on acrylamides, acrylates and acrylic acid, as required by claims 59-60 and 67-68, and that their presence provides a traveling effect wherein the polymer travels into interstitial spaces if water is present thereby causing a plugging effect, and providing effective blockage in confined spaces. See column 5, lines 1-14 and 6, lines 20-29. This teaching would have provided motivation to one of ordinary skill in the art at the time the invention was made to modify the teachings of Pertinelli by including a superabsorbent polymer his composition, with the reasonable expectation of success of forming a substrate coated with an essentially water-free composition, said composition comprising a superabsorbent polymer and a lubricating metal and alloy thereof, and optionally an organic lubricant, wherein said composition is particularly useful in confined spaces in his cable and provides a plugging effect that prevent further invasion of water. Freeman is silent as to the amount of absorption of the superabsorbent particles as well as particle size.

Marciano-Agostinelli teaches a water migration resisting filler comprising a polymeric compound and particles of a water swellable material that is applied to stranded wires of cable, said particles having a particle size of less than 200 microns, per claims 73 and 76. See abstract and column 5, lines 51-53. The particles are of the type contemplated by applicants in claims 59-60 and 67-68, such as acrylamide and acrylate and have a water absorbing capability of 100

times its weight in water, as required by applicants in claims 57 and 65. See column 5, lines 43-62. As to the specific water absorbing properties of the superabsorbent particles, Marciano-Agostinelli teaches particles of the same type contemplated by applicant and as taught by Freeman. The skilled artisan would reasonably presume that the same particles necessarily have the same properties in the absence of factual evidence to the contrary.

Though Freeman is silent as to the specific particle size of his particles, it is the examiner's position that changes in size are ordinarily not a matter of invention and that where the difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device. In the instant case, the present claimed composition having superabsorbent particles of the requisite particle size would not perform differently than the prior art composition. In the alternative, Marciano-Agostinelli teaches the usage of superabsorbent particles having a particle size within the range contemplated by applicants.

As to claims 87 and 88, it should be noted that these claims are product-by-process claims. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or

obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process."

Therefore, the combined teachings of Pertinelli, Freeman, and Marciano-Agostinelli would have rendered obvious the invention as claimed in present claims 57-63, 65-71, 73, 76, and 87-91.

Response to Arguments

8. Applicant's arguments with respect to claims 57-63, 65-71, 73, 76, and 87-91 have been considered but are moot in view of the new ground(s) of rejection.

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jill M. Gray whose telephone number is 571-272-1524. The examiner can normally be reached on M-Th and alternate Fridays 10:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jill M. Gray
Primary Examiner
Art Unit 1774

jmg

RENA DYE
SUPERVISORY PATENT EXAMINER
A.U. 1774 4/17/06